

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Confirmation No.: 9083

Kurt Heaton, et al.

GAU No.: 2623

Serial No.: 09/558,410

Examiner: Hunter B. Lonsberry

Filed: April 24, 2000

For: METHOD AND APPARATUS FOR CONTROLLING AT LEAST ONE SET-TOP  
BOX

M/S Issue Fee  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37**  
**CFR 1.181(a)**

This Petition for Withdrawal of the Holding of Abandonment under 37 CFR §1.181(a) is in response to the Notice of Abandonment, marked Exhibit A, issued by the Office of Data Management dated January 24, 2008, in that the notice indicates Applicants' failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance. Applicants contend that the application is not in fact abandoned.

On December 17, 2007, Applicants paid the Issue Fee due on December 27, 2007, within the three month statutory period, along with a Supplemental Submission of Fees to establish Large Entity status via first class mail. Photocopies of the Postcard, Check #8954, Issue Fee Transmittal and Supplemental Submission of Fees are attached as Exhibits B, C, D and E, respectively. In particular, Applicants call attention to the itemization of fees on

page 1 of Exhibit “E” (the Supplemental Submission of Fees) reflecting the Issue Fee payment of \$1,440.00 in the total fees submitted.

Therefore, the Applicants respectfully petition for: (a) the withdrawal of the holding of abandonment for failure to pay Issue Fee, (b) request reinstatement of the application, and (c) issuance of the patent.

### CONCLUSION

The Office is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the consideration of the petition.

No fee is required for this petition under MPEP § 711.03(c). If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to charge any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Dated: March 18, 2008

/KirkDWong#43284/

Kirk D. Wong

Reg. No. 43,284

2055 Gateway Place, Suite 550  
San Jose, California 95110  
Telephone No.: (408) 414-1080 ext. 214  
Facsimile No.: (408) 414-1076

KDW/AJ  
60097-0098



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,410	04/24/2000	Kurt Heaton	TIVO0020	9083
EXAMINER				
LONSBERRY, HUNTER B				
ART UNIT		PAPER NUMBER		
2623				
MAIL DATE		DELIVERY MODE		
01/24/2008		PAPER		

7590 01/24/2008  
Kirk D Wong  
Hickman Palermo Truong & Becker LLP  
2055 Gateway Place  
Suite 550  
San Jose, CA 95110-1089

JAN 28 2008

## Notice of Abandonment

This application is abandoned in view of:

1. ☐ The applicant's failure to timely file a proper reply to the Office letter mailed on \_\_\_\_\_.
  - (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission date \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113(a) to the final rejection. (A proper reply under 37 CFR 1.113 to a final rejection consists only of:
    - (1) a timely filed amendment which places the application in condition for allowance;
    - (2) a timely filed Notice of Appeal (with appeal fee);
    - (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c) ☐ A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box e below).
  - (d) ☐ No reply has been received.
2. ☒ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission date \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b) ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_.  
The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c) ☒ The issue fee and publication fee, if applicable, has not been recieved.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Trasmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b) ☐ No corrected drawing have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filling of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

Petitions to revive under 37 CFR 1.137(a) or (b), or request to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

Telephone inquiries should be directed to the Office of Data Management at (571) 272-4200.

Patent Publication Branch  
Office of Data Management

DOCKETED

1/28/08

Exhibit "A"

processed by docketing  
no dates docketed

**Acknowledgment Receipt**

Mailing Date: December 17, 2007

Attorney Docket No.: 60097-0098

Serial No.: 09/558,410

Inventor(s): Kurt Heaton, et al.

Title: METHOD AND APPARATUS FOR CONTROLLING AT LEAST ONE SET-  
TOP BOX

Attorney: KDW/aj  
First Class Mail

**Documents Enclosed:**

- 1) Issue Fee Transmittal (1 pg) (in duplicate)
- 2) Supplemental Submission of Fees (2 pgs)
- 3) Check in the amount of \$2,026.00
- 4) Return Acknowledgment Postcard

*Kindly stamp the receipt date and return to addressee to acknowledge receipt of the above documents.*

P0009

NOV 20 2007  
FBI  
ENTRY



Exhibit "B"

HERITAGE BANK OF COMMERCE  
SAN JOSE, CA 95113  
90-4228/1211  
008954

PAY TO THE ORDER OF  
Commissioner for Patents and Trademarks  
\*\*\*\*\*  
\$2,026.00  
DOLLARS

PTO PAYMENT ACCOUNT  
2055 GATEWAY PLACE, SUITE 550  
SAN JOSE, CA 95110

12-12-07

MEMO Docket No. 12-12-07-008954

AUTHORIZED SIGNATURE

Security Features. Details on back.

⑈008954⑈ ⑆121142287⑆ 001566660⑈

Exhibit "C"

# PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: **Mail** Mail Stop ISSUE FEE  
**Commissioner for Patents**  
**P.O. Box 1450**  
**Alexandria, Virginia 22313-1450**  
**or Fax (571)-273-2885**

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

7590

09/27/2007

Kirk D Wong  
Hickman Palermo Truong & Becker LLP  
2055 Gateway Place  
Suite 550  
San Jose, CA 95110-1089

## Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

Annette Jacobs	(Depositor's name)
<i>Annette Jacobs</i>	(Signature)
December 17, 2007	(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,410	04/24/2000	Kurt Heaton	TIVO0020	9083

TITLE OF INVENTION: METHOD AND APPARATUS FOR CONTROLLING AT LEAST ONE SET-TOP BOX

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES <i>NO</i>	\$700 <i>1440</i>	\$0	\$0	\$700 <i>1440</i>	12/27/2007

EXAMINER	ART UNIT	CLASS-SUBCLASS
LONSBERRY, HUNTER B	2623	725-080000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

- ☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
- ☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list

- (1) the names of up to 3 registered patent attorneys or agents OR, alternatively,
- (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

- 1 Kirk D. Wong  
Hickman Palermo  
2 Truong & Becker LLP  
3

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

Tivo Inc.

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Alviso, CA

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☒ Corporation or other private group entity ☐ Government

4a. The following fee(s) are submitted:

- ☒ Issue Fee
- ☐ Publication Fee (No small entity discount permitted)
- ☐ Advance Order - # of Copies

4b. Payment of Fee(s): (Please first reapply any previously paid issue fee shown above)

- ☒ A check is enclosed.
- ☐ Payment by credit card. Form PTO-2038 is attached.
- ☒ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number 501302 (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. ☒ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature \_\_\_\_\_

Date December 17, 2007

Typed or printed name Kirk D. Wong

Registration No. 43,284

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Exhibit "D"

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Kurt Heaton

Serial No.: 09/558,410

Filing Date: April 24, 2000

For: METHOD AND APPARATUS FOR CONTROLLING AT LEAST ONE SET-TOP BOX

Mail Stop IF

Commissioner for Patents

P. O. Box 1450

Alexandria, Virginia 22313-1450

SUPPLEMENTAL SUBMISSION OF FEES—37 C.F.R. 1.28(c)

Sir:

The undersigned patent owner hereby submits an issue fee payment of \$2,026.00 under 37 C.F.R. §1.28(c) for deficient payments made in error. The following is an itemization of the fees paid in error:

<u>Date Paid</u>	<u>Fee Type</u>	<u>Surcharge</u>	<u>Fee Paid</u>	<u>Fee Due</u>	<u>Difference</u>
4/24/00	Filing fee 1.16(a)(2)	None	\$345.00	\$ 760.00	\$ 415.00
4/24/00	Add'l Claims	None	\$171.00	\$ 342.00	\$ 171.00
12/12/2007	Issue Fee	None	\$ 0.00	\$1,440.00	\$1,440.00

Therefore, the Commissioner is authorized to charge our deposit account 50-1302 in the amount of \$2,026.00 for the difference due. The patent owner hereby requests acceptance of the enclosed check in full payment of the deficiency and issue fee due. However, if the amount is insufficient, or in excess of the amount actually due, the Commissioner is hereby authorized to

Exhibit "E"

charge the foregoing total deficiency amount (including any applicable processing fee) or to credit any overpayment to our deposit account 50-1302.

The patent owner further states that, at the time of payment of each of the fees itemized above for the patent, the applicant and the patent owner believed in good faith that the applicant had small entity status. The patent owner recently discovered that such small entity status was claimed in error.

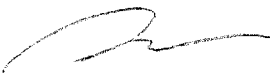
The patent owner also submits that the within payment should be treated as a loss of entitlement to a small entity status under 37 C.F.R. §1.27(g)(2).

Questions regarding the within payment may be addressed to the undersigned.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Date: December 17, 2007

  
\_\_\_\_\_  
Kirk D. Wong  
Registration No. 43,284

2055 Gateway Place, Suite 550  
San Jose, California 95110-1089  
Telephone: (408) 414-1080 ext. 214  
Facsimile: (408) 414-1076

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Issue Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

On December 17, 2007

By

  
\_\_\_\_\_  
Annette Jacobs